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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/747,924	12/29/2003	Jeffrey Mark LaFortune	19457	7068

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KIMBERLY-CLARK WORLDWIDE, INC.
401 NORTH LAKE STREET
NEENAH, WI 54956

EXAMINER

MATZEK, MATTHEW D

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/747,924	LAFORTUNE, JEFFREY MARK	
	Examiner	Art Unit	
	Matthew D. Matzek	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 20-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/19/05, 4/30/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-19, drawn to an absorbent composite, classified in class 442, subclass 327.
- II. Claims 20-33, drawn to method of making an absorbent composite, classified in class 427, various subclasses.
- III. Claim 34, drawn to apparatus to make an absorbent composite, classified in class 118, various subclasses.

The inventions are distinct, each from the other because of the following reasons:

1. Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the method of treating a component to produce a repulsive force within the composite to increase the void volume may be used to create foam reinforcement for footwear.
2. Inventions III and I are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this

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case the article of Invention I may be made repulsive through the use of hydrophobic or hydrophilic coatings.

3. Inventions II and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the method of treating at least one component of the absorbent composite to produce a repulsive force may be done by hand.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Brian Rosiejka on 8/1/2005 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-19.

Affirmation of this election must be made by applicant in replying to this Office action.

Claims 20-34 are withdrawn from further consideration by the examiner, 37

CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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7. The term "increased" in claims 7-10 is a relative term, which renders the claim indefinite. The term "increased" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear to Examiner against what the article with "increased" properties is being compared.

8. Claims 11 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The instant claims recite a "complimentary charge", but do not provide guidance as to how the charges would be acquired by the SAP/fibers or what is meant by complimentary.

9. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear to Examiner as to how the composite may be selectively segregated within the same composite.

10. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Independent claim 1 recites physical properties of an absorbent composite (i.e. improved fluid intake and repulsive forces between the components of the composite).

Dependent claims 7-12 recite physical properties of an absorbent composite (i.e. increased void volume, flow channels permeability, swelling thickness, complimentary and repulsive charges).

11. Ex parte Slob, 157 USPQ states the following with regard to an article claimed by defining property values:

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Claims merely setting forth physical characteristics desired in article, and not setting forth specific compositions, which would meet such characteristics, are invalid as vague, indefinite, and functional since they cover any conceivable combination of ingredients either presently existing or which might be discovered in future and which would impart desired characteristics, thus, expression "a liquefiable substance having a liquification temperature from 40°C to about 300°C and being compatible with the ingredients in the powdered detergent composition" is too broad and indefinite since it purports to cover everything which will perform the desired functions regardless of its composition, and in effect, recites compositions by what it is desired that they do rather than what they are; expression also is too broad since it appears to read upon materials that could not possibly be used to accomplish purposes intended.

12. Thus, claims 1-19 are indefinite for reciting only the desired physical properties of the absorbent composite, rather than setting forth structural and/or chemical characteristics of said absorbent composite.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

13. Claims 1-19 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an absorbent composite comprising fluff fibers and superabsorbent polymer particles (refer to page 6 of the Specification), does not reasonably provide enablement for claimed absorbent composites defined by the specific desired properties made by materials other than the ones disclosed in the Specification. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. The product claims of the present invention are claiming the product by the properties that they are seeking in the absorbent article. It seems that the applicants are attempting to obtain patent protection on a final product made of a

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non-existent process that may be made some day in the future, but only provides guidance on how to make the final product by a specifically disclosed process.

14. The specification does not provide enablement for one of ordinary skill in the art that is reasonably commensurate in scope with the properties sought by the claims.

Claim Rejections - 35 USC § 102

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

15. Claims 1-12 and 15-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Cook et al. (US 6,562,743 B1).

a. Cook et al. teach an absorbent structure comprising fibers bound with a polyvalent cation-containing compound and superabsorbent polymer particles (SAP) (Abstract). The article of Cook et al. may be used in disposable absorbent articles such as diapers and sanitary napkins (col. 8, lines 52-58). The treated fibers of the applied invention may be used in combination with SAP particles to form a stratum of an absorbent core (col. 23-26). The fibers of the applied invention may be fluff fibers (Examples 15 and 16). Along with the polyvalent

cation-containing compound the fibers of the invention may be treated with surfactants, silica or corona discharge to improve their hydrophilicity (col. 6, lines 40-53). This treatment of the fibers increases the core permeability of an absorbent article. The treated fibers do not swell as much as untreated fibers and as a result the interfiber channels or other avenues for liquid to flow through an absorbent structure are kept open to a greater degree (col. 6, lines 5-17). As fibers are exposed to liquid insult the liquid carries the polyvalent metal ion to the SAP particles inhibiting the swelling of the SAP particles allowing gel-blocking (col. 8, lines 43-49 and col. 9, lines 55-62). In an alternative embodiment the SAP particles may also be coated with a polyvalent ion salt, which also results in improved core permeability (col. 10, lines 20-25). The Examiner takes the position that increased core permeability allows for increased void volume, swelling thickness and flow channels due to retardation of SAP and fluff fiber swelling. SAP particles of any size or shape may be used in the applied article including those taught by Kellenberger, US 5,147,343 (col. 8, lines 19-21 and col. 7, lines 45-57).

b. Claims 4 and 5 are rejected as the SAP particles and fluff fibers may be coated with the polyvalent metal ion, but the fluff fibers may also be subjected to corona discharge.

c. Claim 6 is rejected because if the SAP particles are coated with the same ion they will necessarily have the same ionic charge and be repulsed by the other SAP particles possessing the same charge.

d. Claims 15 and 16 are rejected as the fluff fibers and the SAP particles are selectively segregated in the absorbent core layer away from the top and backsheets (col. 1, lines 23-34 and col. 8, lines 23-25).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cook et al. (6,562,743 B1) as applied to claim 1 above, and further in view of Kellenberger (US 5,147,343). Cook et al. is silent as to the specific size of the superabsorbent particles and their size distribution.

a. Kellenberger teaches an absorbent composite comprising a porous matrix of fibers and superabsorbent (SAP) material (Abstract). Several examples are taught by Kellenberger including Example VIII with 57% of the SAP particles between 300 and 600 micrometers.

b. Since Cook et al. and Kellenberger are from the same field of endeavor, (i.e. absorbent composites comprising a porous matrix of fibers and superabsorbent (SAP) material) the purpose disclosed by Kellenberger would have been recognized in the pertinent art of Cook et al.

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c. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the article of Cook et al. with over 50% of the SAP particles with a size between 300-600 microns with the motivation of creating an article with sufficient permeability and surface area for absorption.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

17. Claims 1, 3, 4, 5, 7-10, 15-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 8 of copending Application No. 10/734,004. Although the conflicting claims are not identical, they are not patentably distinct from each other because both are directed to absorbent articles comprising fibers subjected to corona discharge.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Conclusion

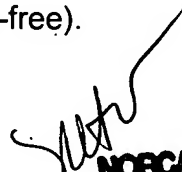
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew D. Matzek whose telephone number is (571) 272-2423. The examiner can normally be reached on 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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